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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,791	11/30/98	BEHR	T 018734/0161

FOLEY & LARDNER  
3000 K STREET N W  
WASHINGTON DC 20007-5109

HM12/0718

EXAMINER
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BURKE, J	
ART UNIT	PAPER NUMBER

1642

DATE MAILED:

07/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/200,791

Applicant(s)

Behr et al

Examiner  
Julie E. Burke (Reeves), Ph.D.

Group Art Unit  
1642



☒ Responsive to communication(s) filed on 27 Apr 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-37 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Claims 1, 2, 18, 19, 22, 24, 25 and 36 have been amended. Claims 1-37 are pending and under examination.
2. The text of those sections of Title 35, U.S.C. Code not included in this Office Action can be found in a prior Office Action.
3. The following Office Action contains some NEW GROUNDS of rejection that have been necessitated by amendment.

#### ***Oath/Declaration***

4. The oath or declaration filed 6/13/200 has been entered. /

#### ***Specification***

5. The use of the trademark 'Periamin' on page 15 line 36, and in claim 19 "Onconase" for example, has been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. It is noted that the use of trademarks in claims is not permissible, as the meaning of the name may be changed by the owner of the trademark during the life of the patent. Please see rejection made under 25 U.S.C. 112, second paragraph below. Applicant's response, which has merely capitalized the term and has not provided a generic terminology, is not sufficient to overcome this objection. /

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6. The disclosure stands objected to because of the following informalities:

The Brief Description of the Drawings is incomplete as it lacks a separate description for Figures 2, 4, 6 and 7. The response states that these comments are not understood. To further clarify, it is noted that Fig 2, for example, contains more than one view. Fig 2 contains two graphs which are designated the upper panel and the lower panel (page 5). These separate panels or views need to be properly labeled as Fig 2A and Fig 2B. The Brief Description of the Drawings needs to be amended so that Figures 2, 4, 6 and 7 recite separate descriptions for each view (i.e., Fig. 2A, Fig. 2B, etc.) that match the labels for the Drawings. Accordingly the brief description of the drawings should reflect this change in the numbering scheme. Also any reference to the figures should reflect the new numbering scheme.

Appropriate correction is required.

***Claim Objections***

7. The objection to Claim 36 is withdrawn in view of the amendment to the claims.

***Claim Rejections - 35 U.S.C. § 112***

8. Claims 2, 19, 22 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 2 and 22 stand indefinite for reciting "antibody fragment conjugates" because it is not clear what fragments of products are encompassed by the scope of the claims.

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An antibody fragment may be as small as one amino acid in size, or even a side chain residue of a single amino acid. Amending the claims to recite "antigen binding fragments" would be sufficient to obviate this rejection. The response set forth on page 5-6 has been considered carefully but is deemed not to be persuasive. The response argues that the specification provides a definition for "antibody fragment". Applicant is reminded that the claims define the subject matter of his invention and that the specification cannot be relied upon to read limitations into the claims. Arguments presented that rely on particular distinguishing features are not persuasive where those features are not recited in the claims.

✓ b. Claim 1<sup>22</sup>9 stands indefinite for reciting the trademark "Onconase" because the meaning of the name may be changed to refer to other compounds during the life of the patent. Also the name is not designated as a trademark. Amending the claim to recite the common generic form of the trademark as supported by the specification as originally filed, would be sufficient to obviate this rejection. Merely capitalizing the term does not overcome this rejection.

9. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ a. The amendments to claims 1, 2, 18, 19, 22 and 24-25 are written in bold text font. It is not clear what meaning is meant to be conveyed by the use of this type of font. It is noted that when the claims go on to be printed, should this application go on to issue, the use of bold

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font will be confusing. It is suggested that the claims be rewritten using only underlining to depict any added text. The dependent claims do not clarify this confusion.

10. The amendment to the Claims 1-37 is sufficient to overcome the 35 U.S.C. 112, first paragraph rejection.

***Double Patenting***

11. The rejection of Claims 1-37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,843,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application encompass antibody binding fragments which are recited in the claims of the issued patent is made again and maintained for the reasons set forth in the previous Office Action. The response set forth on page 7 has been considered carefully but is deemed not to be persuasive. The response argues that the rejection be held in abeyance until allowable subject matter is indicated.

12. No claims are allowed.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Burke, née Reeves, Ph.D, whose telephone number is (703) 308-7553. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Respectfully,

A handwritten signature in black ink, appearing to read "J. Burke".

Julie E. Burke, née Reeves, Ph.D.

Primary Patent Examiner

(703) 308-7553

**JULIE BURKE  
PRIMARY EXAMINER**